

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of July 8, 2010 and respectfully requests reconsideration of the application.

I. The July 2010 paper fails to consider the substance of the claim language

Before amendment, claim 14 recited an “electronic trading system.” All electronic trading systems known to this attorney “match orders against counterorders.” If there are exceptions, they are too few to constitute a material difference. Thus, the distinction drawn in the Action is illusory. The paragraph at the top of page 3 of the Action fails to show a “materially different combination” and thus the restriction fails a showing of “independent and distinct” fails.

Nonetheless, the amendment to claim 14 now removes the distinction relied on in the Action, and the claims are no longer “independent and distinct” for restriction purposes.

II. The Action fails to use form paragraphs that were authorized as of July 2010

The Action uses an obsolete form paragraph, the (a) (b) (c) (d) (e) form at page 3. This form paragraph originated in memo from John Love to the examining corps on April 25, 2007. That memo became obsolete when the MPEP was revised without incorporating the Love criteria into the text. Further, in a Federal Register notice, *Request for Comments on Proposed Changes to Restriction Practice in Patent Applications*, 75 Fed. Reg. 33584 (June 14, 2010), the PTO noted that these two criteria were only “proposed” and “under consideration,” and are not currently available for use.

Paragraph 5 of the Action errs in only giving a laundry list of five possible grounds, without identifying which one is applicable, or identifying the facts or giving an explanation to support that ground. MPEP § 808.02 requires that “[T]he examiner, in order to establish reasons for insisting upon restriction, *must explain* why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must *show by appropriate explanation* one of”

three specific showings.¹ The July 2010 Action contains no such explanation. Without that showing, the July 2010 paper is incomplete, and raises no requirement to elect.

The Action uses an unauthorized short-cut. Form paragraph 8.15 requires one more sentence, which the Examiner cut (leaving the extra trailing period as evidence of an unauthorized edit). Examiners are not authorized to edit the restriction form paragraphs. The Action was not issued pursuant to authority delegated by the Office. No election is required.

III. The Action relies on an incorrect search classification

715/222 is not a correct search class designation. 715/222 is directed to “Subject matter wherein a form document* is generated.” 715/222 is nested within 715/221, “wherein the elements of data define specific locations reserved for entering data.” 715/221 is nested within 715/200, “Subject matter wherein elements of text-only or diverse media type data* are gathered, associated, created, formatted, edited, prepared, or otherwise processed to be presented or wherein the relationship between the elements in a document or portion thereof is defined.” Class 715 is directed to user interfaces. The searchable part of claim 14 does not relate to the user interface, it relates to trading. The best class/subclass for searching claim 14 is 705/37.

IV. Traverse under administrative law statutes

Applicant also traverses pursuant to 44 U.S.C. § 3507 (“An agency shall not conduct or sponsor the collection of information unless in advance of the adoption or revision ... the agency has...” followed the steps for obtaining White House approval), 44 U.S.C. § 3512, and 5 C.F.R. § 1320.6. The PTO neglected to follow the required steps to obtain approval for the Love memo.

Further, “the USPTO must engage in notice and comment rule making when promulgating rules it is otherwise empowered to make.” *Tafas v. Dudas*, 541 F.Supp.2d 805, 812, 86 USPQ2d 1623, 1628 (E.D. Va. 2008). The PTO has not observed the requirements of

¹ See also MPEP § 803(I)(B), § 803(II) ¶ 4, and § 806.01: “Examiners must provide reasons and/or examples to support conclusions” of “unduly extensive and burdensome search,” for example, by “appropriate explanation of separate classification, or separate status in the art, or a different field of search.”

the Administrative Procedure Act (APA) with respect to the Love memo, so it may not be enforced.

V. Provisional Election

If and only if the Examiner can and does cure all of the above defects in the next Office Action, applicant provisionally elects as follows. Applicant notes that all independent claims now recite a “trading system” that does matching of orders. The claims that fall within the group “matching orders against counter orders by a trading system” are claims 1-5, 10-18, 23-25, 30-34, 39-47, 52-54, and 106-120. Applicant provisionally elects that group. If no complete restriction requirement can be framed, all claims must be examined.

VI. Authorization for Email Communication and Conclusion

Applicant hereby authorizes the USPTO to communicate with any authorized representative concerning this application by electronic mail.

Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. For the entire pendency of this application, the Commissioner is authorized to charge any additional required fees (including all extension of time fees), or credit any overpayment, to Deposit Account No. 50-3938, Order No. 01-1041.

Respectfully submitted,

BGC PARTNERS, INC.

Dated: January 10, 2011

By: /David E. Boundy/
Registration No. 36,461

BGC Partners, Inc.
110 East 59th St.
New York, NY 10022
(212) 294-7848
(917) 677-8511 (FAX)